

The opinion in support of the decision being entered today was not written for publication in a law journal and is not binding precedent of the Board.

Paper No. 19

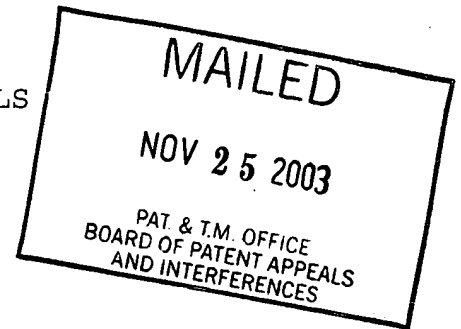
UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte MICHAEL E. REEDY
and EDWARD W. RIDER, JR.

Appeal No. 2004-0211
Application No. 09/677,746

ON BRIEF



Before PAK, OWENS, and WALTZ, Administrative Patent Judges.

OWENS, Administrative Patent Judge.

DECISION ON APPEAL

This appeal is from the final rejection of claims 1-50. The rejection of claims 1-18 is withdrawn in the examiner's answer (page 3).

THE INVENTION

The appellants claim 1) a process for producing a closed-cell polymer foam, 2) an additive for use in a foamable polymer

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composition, and 3) a foamable polymer composition containing the additive. Claim 33, directed toward the foamable polymer composition, is illustrative:

33. A foamable polymer composition comprising: (a) an optionally rubber-reinforced alkenyl aromatic polymer and an additive for (a) consisting essentially of: (b) alpha-methylstyrene; and (c) a rubbery block copolymer.

THE REJECTION

Claims 19-50 stand rejected under 35 U.S.C. § 251 as being based upon a reissue declaration which is defective because the error which is relied upon to support the reissue application is not an error upon which a reissue can be based.

OPINION

We affirm the aforementioned rejection.

The appellants indicate that the claims stand or fall together (brief, page 4). We therefore limit our discussion to one claim, i.e., claim 33. See *In re Ochiai*, 71 F.3d 1565, 1566 n.2, 37 USPQ2d 1127, 1129 n.2 (Fed. Cir. 1995); 37 CFR § 1.192(c)(7)(1997).

Application no. 08/702,922 ('922 application), which issued as patent no. 5,817,261 ('261 patent) which is the basis for the present reissue application, contained the following claim (preliminary amendment filed August 26, 1996, paper no. 3, page 2):

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7. A foamable polymer composition comprising:
 - (a) an optionally rubber-reinforced alkenyl aromatic polymer;
 - (b) alpha-methylstyrene; and
 - (c) a rubbery block copolymer.

The examiner made a restriction requirement among this claim, a process claim, and a claim to a polymer foam (office action mailed January 6, 1997, paper no. 4, page 2). In response to this restriction requirement the appellants elected the process claim and traversed the restriction requirement (response mailed February 10, 1997, paper no. 6, pages 2-3). The examiner maintained the restriction requirement (office action mailed March 13, 1997, paper no. 7, page 2). The appellants did not petition the restriction requirement but, rather, canceled the nonelected claims (amendment filed July 3, 1997, paper no. 9, page 4) and accepted a patent containing only process claims. No divisional application was filed.¹

¹ In parent application 08/163,010 a restriction requirement was made between claims to an alkenyl aromatic foam and claims to a process (office action mailed September 8, 1994, paper no. 5, page 2). In response to the restriction requirement the process claims were elected with traverse and, in that response, the claims to the alkenyl aromatic foam were canceled (response filed October 13, 1994, paper no. 6, pages 1-2). A patent (5,595,694) to the process issued and no divisional application was filed. In grandparent application 07/995,289 a restriction requirement was made between claims to a process and claims to a polystyrene foamed composition, the process claims were elected with traverse, and the appellants instructed the examiner to cancel the claims to the polystyrene foamed composition (notice of allowability mailed May 12, 1993, paper no. 6, pages 2-3). A

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In *In re Orita*, 550 F.2d 1277, 193 USPQ 145 (CCPA 1977), "[a]ppellants' counsel, by telephone, elected the compound and compound-preparation claims and preserved the right to traverse the restriction requirement. However, the traverse was never perfected." *Orita*, 550 F.2d at 1278, 193 USPQ at 146. The court stated that "granting by reissue claims substantially identical to those non-elected in application I would be ignoring the proper restriction requirement set forth in that application in which appellants acquiesced." *Orita*, 550 F.2d at 1280, 193 USPQ at 149. The court stated that "[s]ection 251 is not a panacea designed to cure every mistake which might be committed by an applicant or his attorney," *Orita*, 550 F.2d at 1281, 193 USPQ at 149, and held that the appellants' failure to file a timely divisional application after a restriction requirement is a mistake which that section cannot cure. See *id.*

In the present case, claim 33 of the reissue application and claim 7 of the '922 application differ only in that claim 33 includes the phrase "and an additive for (a) consisting essentially of:". The term "consisting essentially of" limits only the recited alpha-methylstyrene and rubbery block copolymer additive to those components and any other materials which do not

patent (5,269,987) to the process issued and no divisional application was filed.

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materially affect the basic and novel characteristics of the additive. See *Mannesmann Demag Corp. v. Engineered Metal Prods. Co.*, 793 F.2d 1279, 1282, 230 USPQ 45, 46 (Fed. Cir. 1986); *In re Herz*, 537 F.2d 549, 551-52, 190 USPQ 461, 463 (CCPA 1976); *In re De Lajarte*, 337 F.2d 870, 873-74, 143 USPQ 256, 258 (CCPA 1964); *In re Janakirama-Rao*, 317 F.2d 951, 954, 137 USPQ 893, 896 (CCPA 1963). Thus, as in *Orita*, the claims are at least substantially identical. Also as in *Orita*, the appellants acquiesced in the restriction requirement by canceling the nonelected claims. See *Orita*, 550 F.2d at 1280 n.7, 193 USPQ at 148 n.7. In accord with *Orita*, therefore, the appellants' failure to file a timely divisional application is not an error which is correctable by reissue.

The appellants argue that the reissue declaration dated November 26, 2001 (paper no. 7) indicates that the error on which the reissue application is based is not failure to file a timely divisional application but, rather, is in claiming more than the appellants had a right to claim (brief, page 5).² The portion of that reissue declaration pertaining to claiming more than the appellants had a right to claim is directed toward the failure to recite, in the process claims, "that the blowing agent was a non-

² Because the appellants' reply brief is a reiteration of the arguments in the brief, we limit our discussion to the brief.

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solid blowing agent comprised of a combination of atmospheric and organic gases" (declaration, item 6). The declaration, however, also states that "we failed to claim an additive suitable for use in a foamable polymer composition, and a foamable polymer composition comprising an alkenyl aromatic polymer and an additive." See *id.* The failure to claim the additive and the foamable polymer composition in a timely divisional application is the error which cannot be cured by reissue.

The appellants argue that they did not acquiesce to the restriction requirement in the '922 application and its parent and grandparent but, rather, traversed the restriction requirement by stating that all of the claims should have been examined together (brief, pages 5-6). The appellants are incorrect because in canceling the nonelected claims, the appellants acquiesced in the restriction requirement. See *Orita*, 550 F.2d at 1280 n.7, 193 USPQ at 148 n.7.

The appellants argue that the newly added claims "are tied directly to the process claims of the '261 patent and are they [sic, they are] part and parcel of the same invention as the patented process claim" (brief, page 6). This argument is not well taken because claim 7 of the '922 application which, as discussed above, is at least substantially identical to claim 33 of the reissue application, was restricted from the process

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claims and the appellants acquiesced in that restriction requirement. Thus, the record indicates that claim 7 is not tied directly to the process claims as argued by the appellants but, rather, is patentably distinct subject matter.

The appellants argue, in reliance upon *In re Doyle*, 293 F.3d 1355, 63 USPQ2d 1161 (Fed. Cir. 2002), that *Orita* does not apply to the present case because the additive and foamable polymer composition claims were not presented in the '922 application (brief, page 7). The court in *Doyle* stated that one reason why *Orita* did not apply to that case was that "the applicant never asserted the reissue claims or anything similar to them in his original application." See *Doyle*, 293 F.3d at 1360, 63 USPQ2d at 1165. In the present case, in contrast, reissue claim 33 is at least substantially identical to claim 7 of the '922 application, as discussed above.

The appellants also argue, in reliance upon *Doyle*, that if the added reissue claims had been included in the '922 application, all of the claims should have been prosecuted together (brief, pages 7-8). In *Doyle* the added reissue claims were genus claims that linked the claims of the elected and nonelected species in the original application. See *Doyle*, 293 F.3d at 1360, 63 USPQ2d at 1165. It is because the added reissue claims were linking claims that the appellants had the right to

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add them to the original application after the restriction requirement and, therefore, had the right to add them by reissue. See *id.* In contrast to *Doyle*, the appellants' added reissue claims are not linking claims. As stated by the court in *Doyle*, because of the restriction requirement in *Orita*, the new claims added by reissue could not have been asserted with the elected group. See *Doyle*, 293 F.3d at 1360, 63 USPQ2d at 1165. Consequently, the issued patent contained no error. See *id.* Likewise, in the present case, because of the restriction requirement the appellants did not have a right to assert additive claims and foamable composition claims with the elected process claims and, therefore, do not have a right to assert them with the elected process claims by reissue. As in *Orita*, the appellants' issued patent was free of error.

The appellants point out (brief, page 8) that the court in *Doyle* stated that in previous cases such as *Orita*, "it was crucial that the applicant explicitly agreed to the requirement of independent prosecution of the disputed claims (or claims substantially similar to the disputed claims) in a divisional, and not as a part of the application directed towards the elected group." *Doyle*, 293 F.3d at 1360, 63 USPQ2d at 1165. As in *Doyle*, the appellants argue, they did not agree to independent prosecution of the nonelected claims (brief, page 8). This

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argument is not persuasive because the appellants' cancellation of the nonelected claims was, in effect, an explicit agreement to carry out in a timely divisional application any prosecution of those claims and substantially similar claims.

For the above reasons we conclude that the reissue declaration is defective because the error relied upon therein to support the reissue application as to added claims 19-50 is not an error upon which reissue can be based. Accordingly, we affirm the rejection of those claims.

DECISION

The rejection of claims 19-50 under 35 U.S.C. § 251 as being based upon a defective reissue declaration is affirmed.

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No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

AFFIRMED


CHUNG KWAI PAK

CHUNG K/PAK
Administrative Patent Judge

Terry J. Owens
TERRY J. OWENS

Administrative Patent Judge

Thomas A. Waltz
THOMAS A. WALTZ

THOMAS A. WALTZ
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